UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,646	08/05/2005	Karl M Tischler	P05,0183	7104

26574   7590   05/13/2008
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EXAMINER
CHAU, MINH H

ART UNIT	PAPER NUMBER
2854	

MAIL DATE	DELIVERY MODE
05/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2005*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-42* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *23-42* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *12 May 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
       1.☒ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____.
       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1.   Prosecution on the merits of this application is reopened on **claims 23-42**

considered unpatentable for the reasons indicated below:

Applicant is advised that the Notice of Allowance mailed is vacated. If the issue

fee has already been paid, applicant may request a refund or request that the fee be

credited to a deposit account. However, applicant may wait until the application is either

found allowable or held abandoned. If allowed, upon receipt of a new Notice of

Allowance, applicant may request that the previously submitted issue fee be applied. If

abandoned, applicant may request refund or credit to a specified Deposit Account.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   **Claims 23-29 and 33-42** are rejected under 35 U.S.C. 102(b) as being

anticipated by **Hansen et al.** (EP 1246051).

With respect to **claim 23, Hansen et al.** teach (particularly paragraphs [0058 –

0067]) a method and system for printing of a separator sheet [700] with a printer or

copier, comprising the steps of: with aid of a first program module, generating at least

first data that contain at least information for formatting of elements [704] of at least one

separator sheet (software in the computer system that have pull down menu/dialog box
or program module for setting or generating data, see paragraph [0061]), the elements
[704] to be printed on a register tab [702] associated with the at least one separator
sheet [700]; processing the first data with aid of a second program module (dialog box
or pull down menu in the software) so that second data are generated via which print
data for generation of a print image on the register tab (tab separator are generated
based on bookmarks) are added to a print data stream (paragraph [0066]); and printing
at least the register tab [702] of the one separator sheet [700] with the print image by
the printer or copier (see Figs. 1 and 7).

Claims 41 and 42 are similar to claim 23; and therefore are rejected for the
same reason as explained above.

With respect to claim 24, see paragraphs [0061-0066] of Hansen et al. that
teach third data that contain data of the elements to be generated on the register tab
are generated with aid of the first program module (software in the computer system
that have pull down menu/dialog box or program module to allows plurality data of
elements to be generated for the tab).

With respect to claim 25, see paragraphs [0061-0066] of Hansen et al. that
teach data that contain elements to be generated on the register tab are generated with
aid of a third program module (software in the computer system that have pull down
menu/dialog box or plurality of program modules to allows plurality data of elements to
be generated for the tab).

With respect to *claim 26,* see paragraphs [0060, 0066] of *Hansen et al.* that teach the second data and the third data are respectively stored in a file.

With respect to *claim 27,* see paragraph [0063] of *Hansen et al.* that teach the third data contain text data or data of graphic elements.

With respect to *claim 28,* see paragraph [0063] of *Hansen et al.* that teach the first data (formatting information on the tab) and the third data (data information to be generated on the tab) are processed for a first print job (print job for the first tab) with aid of the second program module (program module in the software), the third data being associated with the first print job, and the first data and fourth data are processed for a second print job (print job for the second tab) of the second program module, the fourth data being associated with the second print job (software includes a plurality of program modules to allow plurality of data to be processed for print jobs).

With respect to *claim 29,* see paragraphs [0060, 0066] of *Hansen et al.* that teach a file name of a first file in which the first data are stored and a file name of a file in which the third data are stored, or a file name of a file in which the fourth data are stored are specified as parameters in invocation of the second program module. The data creating/setting including formatting data and printing data for the tab of the separator sheet is stored in the document data file (PDF file), it is clear to one of skill in the art that a file name will being created when a data being save/store by the software in the computer system.

With respect to *claim 33,* see paragraphs [0061-0068] of *Hansen et al.* that

teach the first data contain at least information for arrangement of elements of a

separator sheet set to be printed on register tabs [0064], and that with aid of the second

program module second data [software includes a plurality of program modules (pull-

down menu/dialog box) that allow the setting/generating of data for a tab] are generated

via which print data for generation of respectively one print image on each register tab

of the separator sheet set are added to a print data stream [00666].

With respect to *claim 34,* see paragraphs [0054-0057] of *Hansen et al.* that

teach the separator sheet set serves as a sorting aid for a loose-leaf system.

With respect to *claim 35,* see Fig. 3 and paragraph [0061] of *Hansen et al.* that

teach the first program module is contained as a program element in a desktop

publishing program module as one of the elements selected from the group consisting

of a Java applet, plug-in program module, and a linked program element.

With respect to *claim 36,* see paragraph [0061] of *Hansen et al.* that teach an

assistant function [function in the software] with which all necessary information for

generation of the first data can be activated in the first program module.

With respect to *claim 37,* see Fig. 7 and paragraphs [0064, 0068] of *Hansen et

al.* that teach a view of the separator sheet with register tab of a separator sheet set

with the register tabs is simulated and displayed with aid of the first program module.

With respect to *claim 38,* see paragraph [0061] of *Hansen et al.* that teach the

second program module is executed by a second data processing system (the software

provide pull-down menu/dialog box to allow setting/creating data to be process).

With respect to *claim 39,* see paragraphs [0058-0061] of *Hansen et al.* that

teach the information for formatting contains specifications regarding at least one of the

elements selected from the group consisting of dimensions of the register tab, position

of the register tab in a separator sheet set, paper format of the separator sheet, and

alignment of the register tab.

With respect to *claim 40,* see paragraphs [0061-0068] of *Hansen et al.* that

teach a preview of a separator sheet with selected settings is possible in the first

program module [0061-0064], whereby data with the settings as parameters are

transferred to the second program module, the second program module transfers the

generated second data to the first program module (software in the computer system

includes plurality of program modules that allow setting/generating data for the

separator sheet), and with the first program module the second data are further

processed into display data with aid of a program element.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 30-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hansen et al. as applied to claims 23-29 and 33-42 above, and in view of *Krolczyk et*

al. (US Pat. 6,828,990).

With respect to **claim 30, Hansen et al.** teach a method of generate data for

printing information on the separator sheet and are added to the data print data stream

[paragraphs 0058-0066]. However, **Hansen et al.** does disclose *"data for generation of*

a further print image … sheet outside of the register tab".

Krolczyk et al. teach a method for processing tabbed pages in the document

including generating data of a further print image in at least one section of the separator

sheet (182) outside of the register tab (184) [see Fig. 1 and col. 3, lines 17-67].

In view of this teaching, it would have been obvious to one of skill in the art to

modify the method of **Hansen et al.** to include the steps of generating data of a further

print image in at least one section of the separator sheet outside of the register tab as

taught by **Krolczyk et al.** for the purpose of allowing additional information such as text

or graphic can be printed on the separator sheet or tab sheet.

With respect to **claim 31,** see paragraph [0061] of **Hansen et al.** that teach the

third, fourth or fifth data can be selected via the first or second program module or can

be generated with the help of the first or second program module. The software in the

computer system include a plurality of program modules (pull-down menu or dialog box)

that allows data for the separator sheet to be setting, creating or selecting.

With respect to **claim 32,** see paragraphs [0061-0067] of **Hansen et al.** that

teach the step of creating data for print information on the tab, the data being created

are associated with respective print job. In view of this teaching, It is obvious to one of

skill in the art that that the method that taught by **Hansen et al.** capable of creating a

plurality of data or fifth data that are associated with a respect print job.

6.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.   The Applicant's attention is invited to the patents to Sugimoto

(US Pat. # 6,795,664) and Kuwata et al. (Pub. No. US 2003/0222916A1).

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Minh H. Chau whose telephone number is (571) 272-

2156. The examiner can normally be reached on MON - FRI 11:00AM - 7:30PM.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, JUDY NGUYEN can be reached on (571) 272-2258. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

        Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

                                              /Minh H Chau/
                                              Primary Examiner
                                              Art Unit 2854

MHC
May 07, 2008